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PATENT

By [Signature]

Attorney Docket No. 16265-11-2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Charles D. Lanier, et al.

Application for Reissue of
U.S. Patent 5,103,498
granted April 7, 1992

REISSUE DECLARATION UNDER 37
C.F.R. § 1.175(a)

Filed: April 6, 1994

For: INTELLIGENT HELP SYSTEM

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

We, Charles D. Lanier, Richard J. Wolf, and Leticia Villegas, declare as follows:

1. We are citizens of the United States of America and residents of 3035 Old Mill Run, Grapevine, Texas 76057; 1373 Autry Lane, Crowley, Texas 76036; and 8809 South Pointe Parkway East, Apt 2022, Phoenix AZ 85044, respectively.

2. The entire right, title, and interest to U.S. Patent No. 5,103,498, issued April 7, 1992, is vested in AST Research Inc. a Delaware corporation with a regular and established place of business in Irvine, California by virtue of an assignment from Tandy, Inc., recorded at Reel 6847, Frame 0109, Page 0002. Tandy, Inc., held right, title, and interest to U.S. Patent No. 5,103,498 by virtue of an assignment from us recorded at Reel 5440, Frame 0563.

3. We are the original, first and joint inventors of the invention described and claimed in the above-identified United States Letters Patent and the claims added by the above

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referenced reissue application, for which invention we seek a reissue of the aforesaid Letters Patent.

4. We do not know and do not believe that said invention was ever known or used in the United States of America before our invention thereof.

5. We verily believe the original patent to be partly or wholly inoperative or invalid because of error without deceptive intent on our part. We believe the original patent to be partly or wholly inoperative or invalid because we claimed less than that to which we had a right to claim in the patent. In particular we believe that it was error not to include claims in the original patent such as claims 26 through 59 that are now added as reissue claims. The errors which resulted in the solicitation for reissue and resulted in such claims not being included in the original patent arose due to our failure to appreciate the extent to which the original claims included steps or elements which unduly limited the scope of protection afforded our invention. More specifically, in the original application, we failed to recognize and appreciate features and combinations of the invention which could stand on their own and were patentable over the prior art. The specific errors made in the original patent application and how and when they arose and under what circumstances they were discovered are discussed in the following paragraphs.

6. The error in claiming less than we had a right to claim in the original patent involves our failure to include a claim such as claim 26 now presented in this application for reissue. Claim 26 is a combination method claim that includes a number of method steps from claim 1 but that deletes from claim 1 unnecessary steps that unduly limit the protection afforded our invention by the original patent. Specifically, claim 26 eliminates the steps from claim 1 of "storing a plurality of rules...;", "detecting a request for help information from the

user;", "testing said rules...;", "selecting in response to the proved rules...;", and "displaying said selected help information...." Claim 26 adds the step "using the data indicating said series of user directed events stored in the knowledge base to select help information from said help information data base." The error of not including such a claim in the original application arose because of our failure to appreciate that the combination as recited in claim 26 described essential features of our invention without unnecessary limitations and was patentably distinct over the prior art. The circumstances under which we became aware of this error involved review of the original application by ourselves and our attorneys in light of allegations made in an interference declared between our original patent and a patent application filed by Nonaka, U.S. Patent Office Interference No. 103,022.

7. Claim 26 is further distinguishable from claim 1 in that claim 26 eliminates the language "said method operating independent of said computer program" that is present in claim 1. We believe that it was error not to include such a method claim without this language. We realized at the time we made the invention that a help system incorporating the steps recited in claim 1 could be implemented in such a way that it was either dependent or independent in operation from the computer program. In the original specification at column 12, beginning at line 28 we stated that "one skilled in the art could implement such a help system in another interface environment or without any interface environment." We did include in the original patent system claims for our invention, claim 15 and claim 24, which did not include the aforementioned language. We therefore believe that we had a right to claim a method such as claim 1 that did not include the aforementioned language and that our failure to do so was error. This error resulted from inadvertence without deceptive intent on our part. We have corrected this error by including method claim 26 without the aforementioned language, as well as a number of other claims discussed below in this reissue

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application. The circumstances under which we discovered this error involved review of the original application by ourselves and our attorneys in light of specific allegations made in an interference declared between our original patent and a patent application filed by Nonaka, U.S. Patent Office Interference No. 103,022. In the interference proceedings, party Nonaka made allegations that the aforementioned language limited our original method claims in a way that we did not intend or anticipate when we filed the original application. Upon our review of the original specification and the prior art, we believe that we have a right to method claims that do not include the aforementioned language.

8. We believe that the combination invention as recited in claim 26 is patentable over the prior art cited during prosecution of the original patent. Specifically, claim 26 includes the steps of "monitoring a series of user directed events from an input device;" and "generating data indicating said series of user directed events;" in combination with the other recited steps. The importance of these elements in overcoming the prior art was discussed in the amendment to the original patent application that we filed on June 26, 1991, beginning at page 14, second full paragraph and continuing through page 17, second full paragraph. We hereby incorporate into this declaration and adopt the above cited passage from the aforementioned amendment and believe the arguments made in those passages to distinguish claim 1 over the cited prior art are equally valid to distinguish claim 26 and all the new reissue claims that depend thereon over the cited prior art.

9. Claim 27 is identical to claim 2, but is written to depend on claim 26. We believe that it was error not to include such a claim in the original application for at least the reasons enumerated in paragraphs 6 and 7. This error arose due to the same reasons enumerated in paragraphs 5, 6, and 7. We further believe that claim 27 is patentable over the prior art

for at least the reasons we discussed in the amendment to the original patent application that we filed on June 26, 1991, beginning at page 17, third full paragraph and continuing through page 18, first full paragraph. We hereby incorporate into this declaration and adopt the above cited passage from the aforementioned amendment and believe the arguments made in those passages to distinguish claim 2 over the cited prior art are equally valid to distinguish claim 27 over the cited prior art. This error arose for at least the reasons enumerated in paragraphs 5, 6 and 7. We discovered this error under the circumstances discussed in paragraphs 6 and 7.

10. Claim 28 is identical to claim 3, but depends on claim 27. We believe that it was error not to include such a claim 28 in the original application for at least the reasons enumerated in paragraphs 6 and 7. This error arose for at least the reasons stated in paragraphs 5, 6, and 7. We discovered this error under the circumstances discussed in paragraphs 6 and 7.

11. Claim 29 includes the elements of claim 4 of the original patent with the exception of "checking if the user has requested help;" and is written to depend on claim 26. We believe not including such a claim in the original patent was error for at least the reasons enumerated in paragraph 6 and paragraph 7. This error arose for at least the reasons enumerated in paragraphs 5, 6 and 7. We discovered this error under the circumstances discussed in paragraphs 6 and 7.

12. Claim 30 is identical to claim 8, but depends on claim 26. We believe that it was error not to include such a claim 30 in the original application for at least the reasons enumerated in paragraph 6 and 7. This error arose for at least the reasons enumerated in paragraphs 5, 6 and 7. We discovered this error under the circumstances discussed in paragraphs 6 and 7.

13. Claim 31 depends on claim 26 and in addition recites a limitation where the using step uses "data indicating a series of user-directed events comprising at least two user-directed events." We believe it was error not to include such a claim 31 in the original patent for at least the reasons enumerated in paragraph 6 and paragraph 7. We believe this claim is patentable over the prior art for at least the reasons stated in paragraph 8. This error arose for at least the reasons enumerated in paragraphs 5, 6 and 7. We discovered this error under the circumstances discussed in paragraphs 6 and 7.

14. Claim 32 depends on claim 26 and in addition recites a limitation where the using step uses "data indicating a series of user-directed events that may comprise four or more user-directed events." We believe it was error not to include such a claim in the original patent for at least the reasons enumerated in paragraph 6 and paragraph 7. We believe this claim is patentable over the prior art for at least the reasons stated in paragraph 8. This error arose for at least the reasons enumerated in paragraphs 5, 6 and 7. We discovered this error under the circumstances discussed in paragraphs 6 and 7.

15. Claim 33 depends on claim 26 and in addition recites a limitation wherein the "series of user-directed events are events that are not necessarily related as being part of a particular command hierarchy." We believe it was error not to include such a claim in the original patent for at least the reasons enumerated in paragraph 6 and paragraph 7. We believe this claim is patentable over the prior art for at least the reasons stated in paragraph 8. This error arose for at least the reasons enumerated in paragraphs 5, 6 and 7. We discovered this error under the circumstances discussed in paragraphs 6 and 7.

16. Claim 34 depends on claim 26 and in addition recites a step and limitation: "storing a plurality of rules for analyzing said generated data to determine appropriate help

information; and wherein said using step further comprises using an inference engine to test said rules against the data stored in the knowledge base to select appropriate help information." We believe it was error not to include such a claim in the original patent for at least the reasons enumerated in paragraph 6 and paragraph 7. This error arose for at least the reasons stated in paragraph 5. We believe this claim is patentable over the prior art for at least the reasons stated in paragraph 8. We discovered this error under the circumstances discussed in paragraphs 6 and 7.

17. The error in claiming less than we had a right to claim in the original patent further involves failure to include a claim like or similar to claim 35 presented in this application for reissue. Claim 35 is a combination apparatus claim that includes a number of the elements from claim 15 but that deletes from claim 15 unnecessary elements and limitations that unduly limit the protection afforded our invention by the original patent. Specifically, claim 35 makes the changes from claim 15 described in the following paragraph.

18. In claim 35, the second element of claim 15 has been changed from "a display device" to "an output device." In addition, the seventh element of claim 15, "display engine means", has been deleted from claim 35 and the element "inference engine means" has been changed in claim 35 to include the functionality of "selecting help information for output by said output device to the user". We believe it was error not to include a claim such as claim 35 in the original patent because while computer systems generally will have a display device and display engine means, computer system configurations are possible which use neither a display device nor a display engine means such as computers using an audio output. These elements, which are common to a large number of computer systems, are not necessary to practice our invention nor are they necessary to overcome the prior art. Therefore we believe it was error not to

include a claim like claim 35 that recited a combination not including these unnecessary limitations. This error resulted from inadvertence on our part without deceptive intent. We believe this claim is patentable over the prior art for at least the reasons stated in paragraph 8 and we hereby incorporate into this declaration and adopt paragraph 3, page 18 from the amendment to the original patent application that we filed on June 26, 1991. We discovered this error under the circumstances discussed in paragraph 6.

19. We believe it was error not to include in the original patent a claim now presented as claim 36. Claim 36 includes all the elements of claim 15, but recites one additional element: a "selecting means" coupled to the help information data base that selects appropriate help information and then passes that information to the display engine. Furthermore, the display engine is recited to eliminate the functionality of selecting help information. We believe it was error not to include such a claim because while the specific embodiment of our invention described in the original patent includes a display engine with the functionality of selecting information from a help information data base, it would be obvious to anyone of skill in the software art that such functionality could just as easily be incorporated into a separate selecting means, leaving the display engine means with just the functionality of displaying information to the user. We believe that the recitation of the selecting function as being within the display engine means may unduly limit the scope of protection afforded our invention by claim 15. We therefore believe that it was error not to include such a claim as claim 36 in the original patent. This error resulted from our inadvertent failure to fully comprehend that the invention could be practiced without the limitations recited in the display engine means. We believe this claim is patentable over the prior art for at least the reasons stated in paragraph 8 and we hereby incorporate into this declaration and adopt paragraph 3, page 18 from the amendment to the original patent

application that we filed on June 26, 1991. We discovered this error under the circumstances discussed in paragraph 6.

20. Claim 37 is identical to claim 16, but is written to depend on new claims 35 and 36. We believe that it was error not to include a claim such as 37 for at least the reasons enumerated in paragraphs 18 and 19. This error arose for at least the reasons stated in paragraphs 5, 18, and 19. We discovered this error under the circumstances discussed in paragraph 6.

21. Claim 38 is identical to claim 17, but is written to depend on new claim 37. We believe that it was error not to include a claim such as 38 for at least the reasons enumerated in paragraphs 18 and 19. This error arose for at least the reasons stated in paragraphs 5, 18, and 19. We discovered this error under the circumstances discussed in paragraph 6.

22. Claim 39 is identical to claim 18, but is written to depend on new claims 35 and 36. We believe that it was error not to include a claim such as 39 for at least the reasons enumerated in paragraphs 18 and 19. This error arose for at least the reasons stated in paragraphs 5, 18, and 19. We discovered this error under the circumstances discussed in paragraph 6.

23. Claim 40 is identical to claim 19, but is written to depend on new claims 35 and 36. We believe that it was error not to include a claim such as 40 for at least the reasons enumerated in paragraphs 18 and 19. This error arose for at least the reasons stated in paragraphs 5, 18, and 19. We discovered this error under the circumstances discussed in paragraph 6.

24. Claim 41 is identical to claim 20, but is written to depend on new claims 35 and 36. We believe that it was error

not to include a claim such as 41 for at least the reasons enumerated in paragraphs 18 and 19. This error arose for at least the reasons stated in paragraphs 5, 18, and 19. We discovered this error under the circumstances discussed in paragraph 6.

25. Claim 42 is identical to claim 21, but is written to depend on new claims 35 and 36. We believe that it was error not to include a claim such as 42 for at least the reasons enumerated in paragraphs 18 and 19. This error arose for at least the reasons stated in paragraphs 5, 18, and 19. We discovered this error under the circumstances discussed in paragraph 6.

26. Claim 43 is identical to claim 22, but is written to depend on new claims 35 and 36. We believe that it was error not to include a claim such as 43 for at least the reasons enumerated in paragraphs 18 and 19. This error arose for at least the reasons stated in paragraphs 5, 18, and 19. We discovered this error under the circumstances discussed in paragraph 6.

27. Claim 44 is identical to claim 23, but is written to depend on new claims 35 and 36. We believe that it was error not to include a claim such as 44 for at least the reasons enumerated in paragraphs 18 and 19. This error arose for at least the reasons stated in paragraphs 5, 18, and 19. We discovered this error under the circumstances discussed in paragraph 6.

28. Claim 45 is identical to claim 24, but is written to depend on new claims 35 and 36. We believe that it was error not to include a claim such as 45 for at least the reasons enumerated in paragraphs 18 and 19. This error arose for at least the reasons stated in paragraphs 5, 18, and 19. We

discovered this error under the circumstances discussed in paragraph 6.

29. Claim 45 largely follows claim 1, but eliminates the language referred to in paragraph 7 and eliminates the step "detecting a request for help from the user". Although the step of detecting a request for help will be common to many types of help systems, detecting a request is not a necessary step in order to practice our invention and therefore represents an unnecessary step that may unduly limit the scope of protection afforded our invention. For example, the system could readily use the invention and provide help information to the user regardless of whether the user has specifically requested help information. We therefore believe that it was error not to include a claim such as claim 45 in the original patent application. We believe that this claim and all subsequent claims which depend thereon are patentable over the cited prior art for at least the reasons stated in paragraph 8. We discovered this error under the circumstances discussed in paragraphs 6 and 7.

30. Claim 46 largely follows claim 1, but eliminates the step "detecting a request for help from the user." Although the step of detecting a request for help will be common to many types of help systems, detecting a request is not a necessary step in order to practice our invention and therefore represents an unnecessary step that may unduly limit the scope of protection afforded our invention. For example, the system could readily use the invention and provide help information to the user regardless of whether the user has specifically requested help information. We therefore believe that it was error not to include a claim in the original patent application which is now presented as claim 46. We believe that this claim, and all subsequent claims which depend thereon, to be patentable over the cited prior art for at least the reasons stated in paragraph 8.

We discovered this error under the circumstances discussed in paragraphs 6 and 7.

31. Claim 47 is identical to claim 2, but is rewritten to depend on new claims 45 and 46. We believe that it was error not to include a claim corresponding to claim 47 in the original patent application for at least the reasons enumerated in paragraph 29 and paragraph 30. This error arose for at least the reasons stated in paragraph 5. We discovered this error under the circumstances discussed in paragraphs 6 and 7.

32. Claim 48 is identical to claim 3, but is rewritten to depend on new claim 47. We believe that it was error not to include a claim corresponding to claim 48 in the original patent application for at least the reasons enumerated in paragraph 29 and paragraph 30. This error arose for at least the reasons stated in paragraph 5. We discovered this error under the circumstances discussed in paragraphs 6 and 7.

33. Claim 49 includes the elements of claim 4 of the original patent with the exception of "checking if the user has requested help;" and is written to depend on claims 45 and 46. We believe not including such a claim in the original patent was error for at least the reasons enumerated in paragraph 29 and paragraph 30. This error arose for at least the reasons stated in paragraph 5, 29, and 30. We discovered this error under the circumstances discussed in paragraphs 6 and 7.

34. Claim 50 is identical to claim 5, but is rewritten to depend on new claims 45 and 46. We believe that it was error not to include a claim corresponding to claim 50 in the original patent application for at least the reasons enumerated in paragraph 29 and paragraph 30. This error arose for at least the reasons stated in paragraph 5. We discovered this error under the circumstances discussed in paragraphs 6 and 7.

35. Claim 51 is identical to claim 6, but is rewritten to depend on new claim 50. We believe that it was error not to include a claim corresponding to claim 51 in the original patent application for at least the reasons enumerated in paragraph 29 and paragraph 30. This error arose for at least the reasons stated in paragraph 5. We discovered this error under the circumstances discussed in paragraphs 6 and 7.

36. Claim 52 is identical to claim 7, but is rewritten to depend on new claim 50. We believe that it was error not to include a claim corresponding to claim 52 in the original patent application for at least the reasons enumerated in paragraph 29 and paragraph 30. This error arose for at least the reasons stated in paragraph 5. We discovered this error under the circumstances discussed in paragraphs 6 and 7.

37. Claim 53 is identical to claim 8, but is rewritten to depend on new claims 45 and 46. We believe that it was error not to include a claim corresponding to claim 53 in the original patent application for at least the reasons enumerated in paragraph 29 and paragraph 30. This error arose for at least the reasons stated in paragraph 5. We discovered this error under the circumstances discussed in paragraphs 6 and 7.

38. Claim 54 is identical to claim 9, but is rewritten to depend on new claims 45 and 46. We believe that it was error not to include a claim corresponding to claim 54 in the original patent application for at least the reasons enumerated in paragraph 29 and paragraph 30. This error arose for at least the reasons stated in paragraph 5. We discovered this error under the circumstances discussed in paragraphs 6 and 7.

39. Claim 55 is identical to claim 10, but is rewritten to depend on new claims 45 and 46. We believe that it was error not to include a claim corresponding to claim 55 in the original patent application for at least the reasons enumerated

in paragraph 29 and paragraph 30. This error arose for at least the reasons stated in paragraph 5. We discovered this error under the circumstances discussed in paragraphs 6 and 7.

40. Claim 56 is identical to claim 11, but is rewritten to depend on new claims 45 and 46. We believe that it was error not to include a claim corresponding to claim 56 in the original patent application for at least the reasons enumerated in paragraph 29 and paragraph 30. This error arose for at least the reasons stated in paragraph 5. We discovered this error under the circumstances discussed in paragraphs 6 and 7.

41. Claim 57 is identical to claim 12, but is rewritten to depend on new claims 45 and 46. We believe that it was error not to include a claim corresponding to claim 57 in the original patent application for at least the reasons enumerated in paragraph 29 and paragraph 30. This error arose for at least the reasons stated in paragraph 5. We discovered this error under the circumstances discussed in paragraphs 6 and 7.

42. Claim 58 is identical to claim 13, but is rewritten to depend on new claims 45 and 46. We believe that it was error not to include a claim corresponding to claim 58 in the original patent application for at least the reasons enumerated in paragraph 29 and paragraph 30. This error arose for at least the reasons stated in paragraph 5. We discovered this error under the circumstances discussed in paragraphs 6 and 7.

43. Claim 59 is identical to claim 14 in the original patent except for deletion of the language discussed in paragraph 7. We believe that it was error not to include a claim corresponding to claim 59 in the original patent. We believe it was error not to include a claim such as 59 for at least the reasons we enumerated in paragraph 7. This error arose at least for the reasons we enumerated in paragraphs 5, 6, and 7. We

believe claim 59 to be patentable over the prior art for at least the reasons stated in paragraph 8.

44. We have reviewed and understand the contents of the attached specification and claims, including the new claims as presented in this application for reissue of the original Letters Patent.

45. We acknowledge the duty to disclose information of which we are aware and which is material to the examination of this application for reissue of the original Letters Patent in accordance with 37 C.F.R. § 1.56.

46. The aforementioned errors in claiming less than we had a right to claim arose without any deceptive intention on our part.

47. We hereby declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

48. This declaration may be executed in counterpart and by copy with the same force and effect as if executed as one complete and integrated document.

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